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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,442	09/25/2003	Gary A. Benner	JDC-392 DIV 2	5520

27777 7590 04/05/2004

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EXAMINER	
BRYANT, DAVID P	

ART UNIT	PAPER NUMBER
3726	

DATE MAILED: 04/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/670,442	BENNER, GARY A.	
	Examiner	Art Unit	
	David P. Bryant	3726	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-12 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-12 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5, 6, 10, and 12 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Suzuki et al. (U.S. Patent No. 5,038,464).

Suzuki et al. teach an apparatus for assembling parts, and is readable on the claimed subject matter as set forth below:

Claim 1: In Figures 1-5, note assembly member **10** including at least one pocket **20**, means **13** for moving the assembly member into a plurality of positions **A-I** corresponding to a plurality of assembly stations of the apparatus, means **32** for inserting a first part **30** in a first direction **S** into the pocket at a first assembly station **A**, means **54/55** for connecting a second part **51** to the first part **30** at a second assembly station **D**, and discharge means **70** for discharging the assembled first and second parts from the pocket in a direction substantially opposite the first direction at a third assembly station **H**.

Claim 2: As depicted in Figure 1 and disclosed in column 4 (lines 7-16), the assembly member **10** comprises a plurality of pockets attached thereto via support members **11**.

Claim 3: As depicted in Figure 1, and disclosed in column 4 (lines 16-18), the assembly member is in the form of a rotatable wheel **10** which is rotated in a direction **R** about rotational

shaft **12** via driving means **13**.

Claim 5: As depicted in Figure 1, the rotatable wheel **10** is generally vertically disposed and has a horizontal axis of rotation **12**.

Claim 6: As depicted in Figure 1, and disclosed in column 7 (lines 67-68), discharge means **70** discharges a properly assembled subassembly comprised of first part **30** and second part **51**.

Claim 10: As depicted in Figure 1, and disclosed in column 7 (lines 57-62), means is provided at station **F** for determining whether the first and second parts are properly connected.

Claim 12: As depicted in Figure 2, and disclosed in column 4 (lines 61-64), an urging means **27** is provided to urge the first part **30** into seating contact with the pocket **20** as the pocket is indexed between assembly stations.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 4, 9, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al. (U.S. Patent No. 5,038,464).

Suzuki et al. teach all claimed features, with the exceptions of (1) a servo motor as the driving means **13** for the rotatable wheel **10**, and (2) means disposed between the first and

second assembly stations and the third and first assembly stations for determining whether the first part is properly inserted within or discharged from its respective pocket.

It appears inherent, based on the casing structure depicted for driving means **13**, that the driving means is some type of motor. Regardless, to utilize a motor, and particularly a servo motor, as the driving means would have been obvious to one of ordinary skill in the art, as the use of such motors in indexing assembly apparatuses is notoriously old and well-known, and the selection thereof would have been well within the level of ordinary skill in the art.

Further, since Suzuki et al. teach that it is known to provide a means for determining an assembly condition of parts at an intermediate point as the parts are indexed through various assembly stations, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided additional determining means at other positions along the assembly path, i.e. at the positions recited in claims 9 and 11, to monitor the orientation of parts throughout the entire assembly process, rather than simply near the end thereof.

Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al. (U.S. Patent No. 5,038,464) in view of Andler et al. (U.S. Patent No. 3,802,052).

Suzuki et al. teach all claimed features, with the exceptions of (1) a second discharge means for discharging an improperly connected first part and second part, and (2) a discharge means comprising a means for directing a pulse of pressurized air toward a part in the pocket.

Andler et al. teach a detecting apparatus for detecting whether a first part **10** is properly assembled to a second part **12**. If it is detected that the parts are not properly connected, a pulse of pressurized air is directed toward the part to divert it from the path of properly assembled parts. See Figure 1 and column 3 (lines 41-48).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the detecting apparatus and means for directing a pulse of pressurized air of Andler et al. at the inspection station **F** of Suzuki et al., to detect whether the parts are properly assembled, and divert any defective parts from the assembly path prior to arriving at station **H**.

Double Patenting

The following nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 5-14, and 21, respectively, of U.S. Patent No. 6,675,468. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following:

Independent claim 1 of the patent "anticipates" independent claim 1 of the application. Accordingly, application claim 1 is not patentably distinct from patent claim 1. Since it is clear that the more specific patent claim 1 encompasses application claim 1, following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent

containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

Dependent claims 2-12 of the application are essential duplicates of dependent claims 5-14 and 21, respectively, of the patent.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited references disclose detecting apparatuses and/or turret-type assembly apparatuses. Copies of the references have not been provided, since they were submitted to applicant in parent application Serial No. 10/094,262.

This is a continuation of applicant's earlier Application No. 10/094,262. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Telephone inquiries regarding the status of this application, or other general questions, by persons entitled to the information, should be directed to the group clerical personnel. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information. M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, or fax (703) 872-9301 or by email to CustomerService3700@uspto.gov.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **David Bryant** whose telephone number is **(703) 308-1859**. Draft amendments or proposed changes to the application may be faxed directly to the examiner at any time via RightFAX at (703) 746-4213 (formal inquiries or responses should NEVER be faxed to this number). The examiner can normally be reached on **Mondays-Thursdays from 6:30 AM to 5:00 PM.**

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 703-308-1789. The official fax phone number for the organization where this application or proceeding is 703-872-9306 for all communications (including After Final communications).

Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 308-6789 or (888) 786-0101
Assignment Branch	(703) 308-9723
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/8335
Petitions/Special Programs	(703) 305-9285
Terminal Disclaimers	(703) 305-8408
PCT Help Desk	(703) 305-3257

If the information desired is not provided above, or a number has been changed, please call the general information help line below.

Information Help line	1-800-786-9199
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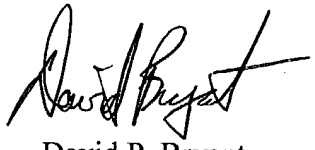

David P. Bryant
Primary Examiner
Art Unit 3726